

REMARKS

Applicants apologize for the mistake in numbering of the claims. The correction by the Examiner is gratefully acknowledged.

Applicants note that a preliminary amendment was filed on January 15, 2002 in this application, and the return postcard indicated it was received by the Patent and Trademark Office on February 27, 2002. This amendment submitted claims numbered as 72-110, which in view of the objections to the numbering should be 71-109. Thus, given the early date at which the preliminary amendment was filed, there should be claims 1-109 pending in the case instead of merely claims 1-70.

The Office Action has rejected all of the pending claims in the above-referenced application under 35 U.S.C. §§ 102(b) and 103(a). In addition, the Office Action has made a statutory type provisional double patenting rejection of claims 1-31, 33-42, and 45-70 claim the same invention as claims 1-70 of the copending patent application 09/987,597 ("the copending application").

The rejections under 35 U.S.C. §§ 102(b) and 103(a) are based on United States Patent No. 5,480,306 issued to Chih-Yuan Liu ("Liu") either alone or in combination with other United States Patents. These other patents include: U.S. Patent No. 6,111,567 issued to Savchenko et al. ("Savchenko"); U.S. Patent No. 5,958,014 issued to Ellis K. Cave ("Cave"); U.S. Patent No. 6,434,745 issued to Conley et al. ("Conley"); U.S. Patent No. 4,963,719 issued to Brooks et al. ("Brooks"); U.S. Patent No. 5,616,876 issued to Jonathan C. Cluts ("Cluts"); U.S. Patent No. 6,264,106 issued to Raj Bridgelall ("Bridgelall"); U.S. Patent No. 6,324,165 issued to Fan et al. ("Fan"); U.S. Patent No. 5,566,291 issued to Boulton ("Boulton"); U.S. Patent No. 6,195,531 issued to Aguirre ("Aguirre"); U.S. Patent No. 6,359,711 issued to Cole ("Cole"); U.S. Patent No. 5,598,540 issued to Steven D. Krueger ("Krueger"); U.S. Patent No. 6,315,195 issued to Natarajan Ramachandran ("Ramachandran"), U.S. Patent No. 5,869,820 issued to Chen et al. ("Chen"), U.S. Patent No. 6,095,418 issued to Schwartz et al. ("Schwartz"), U.S. Patent No. 4,037,302 issued to Hollander ("Hollander"), U.S. Patent No. 4,654,727 issued to Blum ("Blum") and U.S. Patent No. 5,613,137 issued to Bertram et al. ("Bertram").

Applicants respectfully disagree with the rejections for reasons set forth below. Applicants note that in the course of making the various rejections, the Office Action has also conceded that the cited references do not teach many of the claimed

features, which are discussed further. These missing features render the relied upon combinations of references insufficient, and when evaluated together with the lack of motivation insufficient for making obvious the claimed invention. Therefore, it is respectfully requested that all of the rejections be withdrawn and the application allowed to issue without delay.

PROVISIONAL STATUTORY DOUBLE PATENTING REJECTIONS

The Office Action states that claims 1-31, 33-42, and 45-70 of this application claim the same invention as claims 1-70 of the copending application. Applicants wish to alert the Examiner that a petition has been filed by one of the co-inventors in this case (by inventor Kovesdi on April 21, 2003) claiming co-inventorship in the copending application and requesting relief including change in inventorship in the copending application. An information disclosure statement filed in the copending application on April 21, 2003 also points out that there is insufficient authority to prosecute the copending application due to its failure to name the true inventors.

Applicants have amended independent claim 1 to distinguish it from the invention claimed in the copending application. Pending claim 1 following the entry of the amendment to claim 1 is distinct from the corresponding claim 1 since it no longer requires rendering of content "during" detection of the label and instead recites that the rendering of content is "in response to" the detection of the label. Thus, the rendering is necessarily after the detection of the label. Support for the amendment to claim 1 is found, for instance, in Figure 9. The description corresponding to the illustrative Figure 9 in paragraph 99 of the present application reads "cellular-phone 902 . . . decodes the GPS coordinates [] and sends the coordinates . . . to a remote server platform 918 [, which] . . . transforms the location coordinates into an object identifier, looks up the content associated with the object identifier, and sends back the information . . . to phone handset 902." Thus, even the object identifier is deduced prior to sending back of the information rather than while the label is being detected.

Applicants submit the amended claim 1 and all claims dependent upon it do not claim the invention of the corresponding claim 1 in the copending application, and respectfully request that the provisional double patenting rejection with respect to claim 1 and claims 2-12 dependent upon it be withdrawn.

Applicants have made similar amendments in independent claims 13, 16, 31, 36 and 59, which likewise do not claim the same invention as any of the corresponding claims in the copending application. Accordingly, applicants respectfully request that the provisional double patenting rejection of claims 8, 13-17, 31, 33-37, and 59-63 be withdrawn. In addition, applicants request that the

provisional rejections of the remaining claims be addressed upon allowance of the claims.

Applicants further note that notwithstanding these amendments, the subject matter of the originally filed claims may be pursued by the applicants in subsequent proceedings. In other words, the amendments are without prejudice.

OVERCOMING REJECTIONS UNDER 35 U.S.C. 102(B)

The Office Action has rejected claims 18, 19, 21, 22, 31, 34, 38, 54, and 58 under 35 U.S.C. § 102(b) for allegedly being anticipated by the Liu patent, which was cited by the applicants themselves. Of these rejected claims, claims 18, 31 and 38 are independent. For the sake of economy, Applicants have discussed only the rejections of the independent claims in detail since the limitations present in the independent claims (and missing from the disclosure of Liu) are also necessarily present in their respective dependent claims.

As to claim 18, Liu does not teach the detection of a label 'associated with an object' as is required and instead discloses detection of a label associated with content such as sounds. Not surprisingly, there is no teaching, disclosure or suggestion of using its content rendering identifiers to label objects such as the slides cited by the Office Action. Thus, the subsequent rendering of content bound to the object or an object identifier described in claim 18 is not disclosed or suggested by Liu.

The Office Action suggests that the printing of codes on slides or visible media provides the required object. However, the printed code of Liu in no way labels the object, and is instead only labeling the rendering of content according to Liu itself. Typically, multiple labels would be required for representing arbitrary content, with the number and nature of labels dependent upon the particular content to be rendered rather than the object. Liu does not even suggest that the code is useful for identifying the object it is printed upon. Nor is such a function inherent since the code is by its very design unrelated to the particular object it is printed upon. See figures 2-4 of Liu. Indeed, the distinct recitation of content and object in claim 18 are meaningless in the context of Liu, since Liu only discloses content rendering identifiers rather than object identifiers, and thus teaches away from the claimed invention. This distinction is also noted in the specification of the present application in paragraph 12, which explains that Liu requires defining an assignment between codes and words and sentences (instead of physical objects/locations/events and the like). Therefore, the rejection of claim 18 and claims 19, 21, 22 dependent upon it should be withdrawn.

The reasons set forth above with respect to claim 18 also apply to independent claim 31, which clearly recites "using the database to bind content to the object identifier." There is no such association or database in Liu nor are there any object

identifiers. Therefore, the rejection of claims 31 and 34 (dependent upon claim 31) should be withdrawn.

Claim 38 recites “a plurality of machine readable labels relevant to the physical world” in describing the association between physical objects, locations, and/or temporal events and object identifiers. Clearly, in light of the prior discussion, Liu fails to disclose or suggest such an association. Therefore, the rejection of claim 38 and claims 54, and 58 (dependent upon claim 38) should be withdrawn.

OVERCOMING REJECTIONS UNDER 35 U.S.C. 103(a)

All of the obviousness based rejections rely upon at least the Liu reference, which is already shown to be insufficient to anticipate any of the pending claims. In addition to the limitations discussed previously, the Office Action itself makes the several observations regarding the deficiencies in the prior art in the course of its exhaustive and thorough examination. At least the following features of the claimed invention are also not disclosed according to the Office Action in the various combinations of the references:

1. Liu fails to teach a method for authoring information and a system for authoring the content.
2. Liu, even as modified by Savchenko, still fails to teach content is a link to a live agent.
3. Liu, even as modified by Savchenko, still fails to teach aggregating content into a single entity – the ‘tour.’
4. Liu, even as modified by Savchenko, still fails to teach detecting a second label associated with the first object and normalizing the first and second label such that content bound to the first object can be rendered during (or in response to) detection of either the first or second label in the playback mode.
5. Liu, even as modified by Savchenko, still fails to teach a step of uploading and downloading content to a remote server.
6. Liu, even as modified by Savchenko, still fails to teach that uploading is performed via a wireless network.
7. Liu fails to teach that rendering the content comprises streaming the content from a remote server.
8. Liu, even as modified by Savchenko, fails to teach a remote server
9. Liu, even as modified by Savchenko, still fails to teach that instructions allow a plurality of different label types to be normalized to one object identifier.
10. Liu fails to teach determining current time and comparing current time to the time stamp prior to rendering content.
11. Liu fails to teach accepting annotations/feedback after rendering of the content and binding the annotations/feedback to the object identifier.
12. Liu, even as modified by Boulton, fails to teach storing the annotations/feedback in a remote memory.
13. Liu fails to teach that at least one of the labels is custom created.
14. Liu, even as modified by Savchenko, still fails to teach that the physical world comprises labeled locations containing labeled objects, proximity of which may be determined by the labeled locations.
15. Liu, in combination with Savchenko and Cluts, still fails to teach that the wireless network comprises cellular telephone network.
16. Liu fails to disclose that the apparatus accesses the tour via the Internet and a voice portal.
17. Liu fails to teach accessing the tour via a cellular telephone voice mailbox.
18. Liu fails to teach that digital multimedia is accessible by the apparatus in a sequential order.
19. Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

20. Liu, even as modified by Savchenko, still fails to teach that the circuitry comprises an IR tag reader.
21. Liu, even as modified by Savchenko, still fails to teach a circuitry for determining a coordinate location.

These conclusions of the Office Action are in addition to the demonstration by applicants that Liu does not teach or suggest associating physical objects, events, locations and the like with labels, and instead associates labels with content alone. Since all of the independent claims recite labels associated with an object (rather than content), this additional drawback of Liu is relevant to the rejection of all of the claims. Thus, Liu is wholly unsuitable for rejecting any of the claims. Because this deficiency of Liu is not only not cured by any of the other cited references, it also removes the motivation, if any, for combining the various references with Liu. Such a motivation is required for making and maintaining an obviousness based rejection for each and every one of the eighteen different obviousness based rejections (paragraphs 5 and 7-24) in the Office Action.

As is well established, the motivation to combine should be found within the record and care needs to be exercised to avoid combinations of references that are based on hindsight. The absence of object identifiers in Liu, and in Savchenko is inconsistent with the proffered motivation for generating the various combinations.

For instance, in the context of the pending claim 1, and in light of the prior discussion, Liu does not disclose unambiguous binding of content to an object by the very nature of Liu's disclosure. This is so since it is the content that is labeled in Liu, see, e.g., column 2, lines 25-35, rather than the object. As a result, at best Liu discloses content rendering identifiers at best instead of object identifiers.

Savchenko does not provide the missing object identifiers either. Therefore all rejections based on the combination of at least Liu with Savchenko should be withdrawn. Accordingly, the rejections of claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64, and 66-67 should be withdrawn.

Similarly, Cave also fails to provide a motivation to combine it with Liu and Savchenko. Therefore the rejection of claims 6 and 23 should be withdrawn.

Since Liu and Savchenko do not disclose object identifiers, there is no motivation to combine them with Conley. Therefore, the rejection of claims 7, 14, 36, 37, 49, and 53 should be withdrawn.

The failure of Liu and Savchenko to use object identifiers makes their combination with Brooks artificial and driven by pure hindsight. Therefore, the rejection of claims 8, 15, 33, and 35 should be withdrawn.

Since neither Liu and Savchenko, alone or in combination, use object identifiers, nor does Cluts provide object identifiers and a motivation to combine them, the rejection of claims 10, 11, 12, 20, 25, 45-47 and 65 should be withdrawn. The failure of Boulton to provide the necessary motivation further requires that the rejection of claims 26-28 be withdrawn. In addition, the teaching of a cellular telephone network by Aguirre is insufficient to provide the required motivation. Therefore, the rejection of claim 48 should also be withdrawn.

Similarly, Bridgelall also is insufficient to provide a motivation to combine it with Liu and/or Savchenko. Therefore, the rejection of claims 17, 62, and 70 should be withdrawn.

The teaching of a timer by Fan is also insufficient to provide the necessary motivation to combine it with Liu. Therefore, the rejection of claim 24 should be withdrawn.

Not only do Liu and Savchenko fail to teach that the physical world comprises labeled locations containing labeled objects, they do not use object identifiers. Therefore, there is no motivation to combine them with Hollander and/or Blum. Therefore, the rejection of claims 43 and 44 should be withdrawn.

Likewise, Cole's teaching of voice mail and Internet fails to provide the motivation to combine it with Liu. Cole is also insufficient to provide the motivation to combine Aguirre with Liu. Thus, the rejection of claims 50-52 should be withdrawn.

The sequential storage of data taught by Krueger is insufficient motivation to combine it with Liu. Therefore, the rejection of claim 55 should be withdrawn. The portable terminal of Ramachandran that reads bar codes is also not sufficient to maintain the rejection of claim 56 and 57.

Chen's teaching of an infrared tag reader is similarly insufficient to provide the motivation to combine it with Liu and/or Savchenko, thus requiring the withdrawal of the rejection of claims 61 and 68.

The touchpad location determining circuitry of Bertram is likewise insufficient to provide the motivation to combine Bertram with Liu and/or Savchenko. Therefore, the rejection of claim 69 should be withdrawn.

There is no motivation to combine Schwartz with Liu since Liu lacks any teaching of object identifiers. Therefore, the rejection of claim 32 should be withdrawn as well.

Taken together, in view of the preceding discussion, all of the obviousness based rejections of claims 1-17, 20, 23-30, 32, 33, 35-37, 39-53, 55-57, and 59-70 under 35 U.S.C. § 103(a) should be withdrawn.

MISCELLANEOUS MATTERS

Applicants note that claims, filed numbered as 72-110, were submitted in a preliminary amendment filed on January 15, 2002, which have not been examined or entered.

Receipt of the January 15, 2002 preliminary amendment by the Patent Office is acknowledged by the PTO stamp on the self addressed postcard, a copy of which is attached. For the Examiner's convenience, applicants are attaching a copy of the preliminary amendment along with proof of its receipt by the PTO. In view of this, it is respectfully requested that the previously submitted claims also be entered and examined and that applicants be given a chance to respond to a first Office Action relating to them. Applicants note that the numbering of the claims needs to be corrected as being 71-109. Applicants will provide a more complete list of the renumbered pending claims upon the entry of the preliminary amendment.

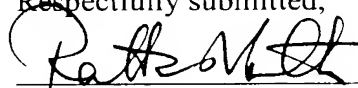
CONCLUSION

Following the entry of this response and claim amendments herein all of the pending claims 1-109 are placed in form for allowance, although only claims 1-70 have been subject to examination. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No fee is estimated to be required for this submission other than the fee for the accompanying Petition for Extension of Time of three (3) months. Please charge any required fee to Deposit Account No. 16-1150.

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Respectfully submitted,



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